

### REMARKS

In the outstanding Office Action, claims 3-10 were presented for examination. Claims 4-5 AND 8-10 were rejected on formal grounds under 35 U.S.C. §112. In addition, rejection was advanced on the basis of 35 U.S.C. §102 against claims 3, 6 and 7 as being anticipated by a reference to Roller.

The Office Action has been most carefully studied. In this amendment applicant has amended claims 3, 4, 9 and 10, and has added new claims 11-15 more particularly pointing out the invention. The new claims have been carefully written to avoid any questions under 35 U.S.C. §112, in accordance with the guidelines and requirements set forth in the outstanding Office Action. Accordingly, as will be discussed in detail below, it is believed that the application is clearly in condition for allowance.

### *Re-mailing of Action*

The Office's courtesy in re-mailing the outstanding action on December 27, 2005 to the undersigned's customer number, pursuant to the request and accompanying power filed by fax on August 26, 2005, is greatly appreciated by applicant.

### *Claim Amendments*

New base claim 3 has been amended in minor respects to make explicit language which was inherent or to better emphasize the novelty of the invention. The dependencies of claims 4 and 9 have been corrected to reference claim 3 rather than canceled-claim 1. Applicant regrets this minor oversight in the previous amendment and notes that the intended dependency was made clear in the remarks which indicated that "New claims 4-10 each depend from claim 3."

### *Claim Rejections - 35 U.S.C. §112 Second Paragraph*

The rejections under 35 U.S.C. §112 second paragraph have been carefully considered and are believed to have been overcome by the amendments now made.

*Claim Rejections - 35 U.S.C. §102(b) Anticipation*

As explained in the amendment filed April 11, 2005 the invention as now claimed in amended base claim 3 provides a novel protector for the vertical support posts of safety rail barriers of the type currently used along roads and highways. The protector can also be used for future safety rail barriers employing comparable support posts. Specific embodiments of the claimed protector are useful, *inter alia*, for protecting an accident victim from ground-sliding contact with one of the vertical supports.

The invention as now claimed provides a simple, low cost, easily installed protector for an exposed, typically metallic, portion of a safety or guard rail support post. Embodiments of the claimed protector can absorb impact shock and provide damping or cushioning to reduce possible injuries, including head injuries.

Claim 3, as now amended, is believed clearly and patentably distinguished from Roller, or any other reference known to applicant, as will now be explained.

Claim 3 is directed to a protector comprising an integral body having an extruded outer profile "*configured to surround a respective support post except for a vertically open section*" which is clearly distinguished from the reference to Roller. Roller's protector comprises two body components 14, 16 which are not integral one with another because they require a belt or strap 18 to hold them together. Roller's components 14, 16 are separately constituted, must clearly be separately assembled around a support post and would not remotely be considered "an integral body" by one skilled in the art. One component 14 or 16, considered alone, does not surround the support post extending as it does only half way around the post and would not, alone, provide adequate protection.

In addition, when surrounding a support post, components 14, 16, considered together, do not have a vertically open section, as required by amended claim 3: they

completely surround the post. Applicant notes that the Office appears to be in error in asserting that the claims "do not require protector to surround the post" on page 4 of the outstanding Office action, as this language appears in lines 7-9 of claim 3 before amendment.

Furthermore, amended claim 3 calls for the integral body of the protector to have a "*generally U-shaped internal configuration permitting the integral body to conform with and attach to the support post*". Roller does not meet this requirement either. One component 14 or 16, while possibly having a U-shaped interior configuration, does not provide a protector, and indeed Roller does not disclose a protector comprising a single component 14 or 16. Roller's protector comprises the two body components 14, 16 and a band or strap 18. The two components 14, 16 considered together, do not have a U-shaped configuration: their combined shape lacks a pair of open limbs through which the support post can be received. Nor does the internal configuration of Roller's protector "*permit attachment*". The two components 14, 16, may fit the support, but their internal shape does not attach the protector to the support. Attachment is effected by Roller's strap or band 18. In contrast, applicant's claimed protector is attached to the post by its internal configuration, and, in preferred embodiments, for example as claimed in claim 7, the attachment can be a releasable snap fit, like a circlip.

Still further, amended claim 3 calls for the integral body to have "multiple internal partitions defining cells, the cells providing a compressible internal structure". Roller's components 14, 16 might at best be considered to provide a single internal partition, not "multiple internal partitions", but components 14, 16, considered together do not constitute an "integral body", as was explained above. A single component 14 or 16, clearly lacks the partitions and compressible internal structure provided by the internal cells.

Thus amended claim 3 is believed clearly and patentably distinguished from claim 3 and therefore allowable.

#### *Dependent Claims*

Claims 4-?? depend from base claim 3, and are therefore believed allowable with claim 3 for the reasons that claim 1 is believed allowable. Dependent claims 4-10 are furthermore believed clearly and patentably distinguished from the art of record, and therefore allowable, by the additional meaningful limitations they recite.

More particularly, claim 4 calls for the integral body to have an injury reducing smooth outer surface, which could be formed, for example of sheet metal and is quite unlike Roller's potentially hazardous contouring. In addition, the integral body claimed in claim 4 provides greater protection for aspects of the support post which are more likely to be impacted; which is not remotely suggested by Roller or any other art known to applicant.

Nor can the feature of claim 5 wherein an open section of the extruded profile located in an external zone of improbable impact be suggested by Roller which lacks an open section.

Claim 6, and also base claim 3, call for the integral body of the protector to have an extruded outer profile or to be the product of an extrusion process. The Office gave no patentable weight to this limitation because it was considered to be a product-by-process limitation, citing MPEP 2113. The Office is respectfully requested to reconsider this position in light of the second paragraph of MPEP 2113, which reads as follows:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed

composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

Applicant's extruded profile is considered, in this respect, to be equivalent to terms such as "welded" or "etched" which were given weight. Roller's body components 14, 16 clearly cannot be extruded because, for example, extrusion could not provide the indentations 30 and 50.

Furthermore, the internal configuration of the integral body defined in claim 7 provides a construction which can be embodied as a snap-fit of the protector to a support post of I-beam ("double-T") configuration, which combination with claim 3 is not remotely taught or suggested by Roller or any other art known to applicant. Nor did the Office explain how the features of claim 7 were believed anticipated.

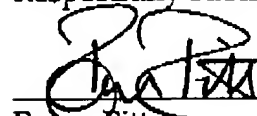
In addition to some of the foregoing features, claim 8 calls for peripheral portions of the integral body to provide latches which are not remotely disclosed or suggested by Roller.

Roller does not remotely disclose or suggest the combinations provided by the additional respective features of claims 11-13, namely that the integral body has an sinuous-shaped, extruded internal profile, is a one-piece body and is removably attachable to the support post without requiring an additional fastening device. Nor does Roller suggest the novel combination of these features with the respective features of claims 3 and 7, as are set forth in new claims 14 and 15.

In view of the above amendments and the discussion relating thereto, it is respectfully submitted that the instant application, as amended, is in condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicant's representative would be helpful in the advancement of the prosecution, they are invited to call the telephone number below for an interview.

Respectfully submitted,

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